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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,471	07/17/2003	Kinya Kodama	240485US0	9185

22850 7590 02/09/2005

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EXAMINER

BERMAN, SUSAN W

ART UNIT PAPER NUMBER

1711

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,471

Applicant(s)

KODAMA ET AL.

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-3 and 5-6 are rendered indefinite by the use of the phrase "general formula" which makes it unclear whether applicant intends to claim compounds of the formula set forth or compounds having the same "general" formula. Claim 7 is indefinite because it does not set forth the manner of "using" the material of claim 1 to form a waveguide. In claims 7 and 8, it is not clear how or what "forming" or "photolithography" steps, such as coating and irradiating the material through a photomask, must be employed to obtain a waveguide.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al (5,457,003 or equivalent JP 04-338958 or equivalent EP 466025). Tanaka et al disclose compositions comprising a photoacid generator and a polysiloxane obtained by hydrolysis and condensation with dehydration of an alkoxysilane having an oxirane ring, optionally with an alkoxysilane having no oxirane

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ring. See the abstract, column 8, line 46, to column 9, line 52. The process comprising processing the composition by photolithography is taught in column 12, line 60, to column 13, line 30, and column 14, lines 1-15.

Claims 1, 2 and 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Toyoda et al (6,537,723). Toyoda et al disclose compositions for forming optical waveguides comprising a silicone oligomer of formula 2 and a polymerization initiator. See column 4, lines 25-62, column 10, lines 64-67, and column 15, lines 39-67. A photolithographic method for forming a waveguide is taught in column 6, lines 28-57.

Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Sekiguchi et al (6,207,728). Sekiguchi et al disclose compositions comprising an organopolysiloxane and a photoacid generator. The organopolysiloxane is obtained from a hydrolyzable silane containing a non-hydrolyzable group which can be an oxetane or epoxy group in embodiment one or a hydrolyzable silane containing an oxetane group in embodiment four (column 6, lines 15-26, and column 14, line 4, to column 15, line 9). See column 5, line 10, to column 6, line 67, and Examples 5, 6, 9 and 10. The organopolysiloxane produced by ring opening of the oxetane group would be expected to produce an organopolysiloxane within the formula set forth in instant claim 4.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Deichmann et al (5,952,044) disclose polyorganosiloxanes corresponding to those in the instant claims but do not teach adding a photoacid generator. Leclaire (5,357,024) discloses compositions for coatings

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having a high refractive index comprising a titanate and polyorganosiloxanes corresponding to those in the instant claims but do not teach adding a photoacid generator.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Susan W Berman
Primary Examiner
Art Unit 1711

SB
2/4/05